

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 5367-054-228	FOR FURTHER ACTION		See item 4 below
International application No. PCT/US2004/037664	International filing date (<i>day/month/year</i>) 10 November 2004 (10.11.2004)	Priority date (<i>day/month/year</i>) 11 November 2003 (11.11.2003)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant SOCIETE BIC			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 4 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 15 May 2006 (15.05.2006)
Facsimile No. +41 22 740 14 35	Authorized officer <div style="text-align: center; font-weight: bold; margin: 10px 0;">Dorothee Mülhausen</div> Telephone No. +41 22 338 87 40

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

REC'D 19 MAR 2006

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WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:
KAREN G. HOROWITZ
JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017-6702

Date of mailing
(day/month/year)

19 MAR 2006

Applicant's or agent's file reference

5367-054-228

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/US04/37664

International filing date (day/month/year)

10 November 2004 (10.11.2004)

Priority date (day/month/year)

11 November 2003 (11.11.2003)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): B43K 27/04, 27/08 and US Cl.: 401/16, 17, 29-35

Applicant

SOCIETE BIC

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US:
Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Facsimile No. (571) 273-3201

Date of completion of this opinion
01 February 2006 (01.02.2006)

Authorized officer

For Justine Yu

Telephone No. 571-272-

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/US04/37664

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of:

- ☒ the international application in the language in which it was filed
- ☐ a translation of the international application into _____, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

- ☐ a sequence listing
- ☐ table(s) related to the sequence listing

b. format of material

- ☐ on paper
- ☐ in electronic form

c. time of filing/furnishing

- ☐ contained in the international application as filed.
- ☐ filed together with the international application in electronic form.
- ☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US04/37664

Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>1-23, 29 and 32-43</u>	YES
	Claims <u>24-28, 30, 31</u>	NO
Inventive step (IS)	Claims <u>1-23 and 39-43</u>	YES
	Claims <u>24-28, 29-31 and 32-38</u>	NO
Industrial applicability (IA)	Claims <u>1-43</u>	YES
	Claims <u>NONE</u>	NO

2. Citations and explanations:

Claims 24- 28, 30 and 31 lack novelty under PCT Article 33(2) as being anticipated by Keil. Keil discloses a writing instrument comprising: an outer barrel 42, a first writing element 49; and a second writing element having a porous tip 47; the inner and outer writing elements axial movable with respect to each other; and outer barrel 49 is configured to permit access to at least one of the inner and outer writing elements.

Regarding claims 25 and 26, the removable member is a front nose cone 46.

Regarding claim 27, the outer barrel 42 comprising a front barrel 25 separable from a back barrel 42.

Regarding claim 28, the second writing medium 44a has a filler type writing medium reservoir 44b.

Regarding claim 29, the writing instrument comprises a writing medium impervious sleeve 51 covering at least a portion of the writing medium reservoir 44a and the porous nib 47 of the second writing element.

Regarding claim 31, the first and second writing elements 49 and 47 are coaxially positioned within the outer barrel 42.

Claims 29 and 32-38 lack an inventive step under PCT Article 33(3) as being obvious over Keil in view of Wagner. Keil discloses a writing instrument comprises an outer barrel 42; a filler-type writing medium reservoir 44a within the outer barrel 42; a porous nib 47. Keil does not specifically disclose a writing medium impervious element covering the outer surface of the writing medium reservoir. Wagner teaches a writing medium impervious element 38 covering the outer surface of the writing medium reservoir 34. It would have been obvious to one of ordinary skill in the art to provide a writing medium impervious element on the Keil writing medium reservoir in view of the teaching of Wagner for covering the outer surface of the writing medium reservoir to preventing soiling.

Claims 1-23 and 39-43 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest a writing instrument comprising: an inner writing element having a first writing tip and a first writing medium reservoir; and outer writing element having a second writing tip and a second writing medium reservoir; the outer writing element is movable respect to the outer barrel; and a driving mechanism operatively coupled to and locate to the rear end of the outer writing element; and actuation of the driving mechanism cause axial movement of the outer writing element.

Claims 1-43 meet the criteria set out in PCT Article 33(4), and thus writing instrument industrial applicability because the subject matter claimed can be made or used in the pen industry.